

Remarks

The § 112 Rejection of Claim 19

The Examiner rejected Claim 19 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement stating that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that Applicants had possession of the invention at the time the application was filed. Specifically, the Examiner points out that the claimed time period of “one second or less” does not appear to have basis in the original disclosure.

The Examiner also rejected Claim 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the claim language “when there is when shifting” was considered awkward and not understood.

Applicants have amended Claim 19 by deleting the phrase “the time is one second or less” and the term “when” from the claim. The phrase “is delayed for 0.1 to 1s” has been added. Support for this amendment is found in paragraph 0012 of the specification. The amended Claim 19 better captures the novel aspects of the invention and particularly points out and distinctly claims the subject matter the Applicants regard as the invention. Applicants respectfully request reconsideration and withdrawal of the § 112, first and second paragraph rejections of Claim 19.

Statement of Common Ownership

The undersigned attorney hereby states:

U.S. Patent Application No. 10/791,123 (the instant application) and U.S. Patent No. 6,098,772 were, at the time the invention of U.S. Patent Application No. 10/791,123 was made, commonly owned by Luk Lamellen und Kupplungsbau GmbH (“Luk”).

The Rejections of Claims 1-6 under 35 USC § 103 (a)

Claims 1-6 were rejected under 35 USC §103(a) as unpatentable over admitted prior art described in paragraph [0002] in view of U.S. Patent No. 6,234,290 ("Drexl"). Applicants respectfully traverse the rejections.

Claim 1 has been amended to include that the pressure relief device is operable by the driver via an actuating device. Previously, this element was recited in Claim 4 which has been cancelled in this reply.

Drexl only describes a manually operated master cylinder that has a pneumatic system not a hydraulic system as recited in Claim 1. Also, the clutch disclosed in Drexl is not disengaged in the force-free state of the clutch. It is impossible to actuate a clutch which is disengaged in the force-free state with a clutch pedal. Drexl also fails to disclose a clutch operated by an actuator. Clutches that are actuated by a clutch pedal are closed by pressing a foot on the clutch pedal and released by lifting the foot off of the clutch pedal. The clutch of the present invention is only operated by an actuator. Drexl and other prior art do not disclose a clutch operated by an actuator in a force-free state.

Furthermore, Drexl does not disclose a pressure relief valve which is operated from the outside which is clearly shown in Figure 1 and described in Col. 20 & 21 of Drexl. In other words, the function of the relief valve is not initialized inside the hydraulic circuit. Additionally, Claim 1 recites that the relief valve must be actuated to set back a pressure applied between the master cylinder and the slave cylinder, and that pressure relief valve is operable by the driver via an actuating device. Drexl discloses an excess pressure valve inside the hydraulic circuit to limit the force at the end of activation travel. This is very useful for limiting excess pressure in an opened clutch which is engaged in the force-free state. However, this is not the approach of the pressure relief valve recited in Claim 1 of the present application. The approach of the present application is to avoid an emergency state if an actuator fails. Therefore, the pressure of the system of Claim 1 of the present application is not limited, but it has to be set to null in an emergency state to open the clutch and not limit the pressure of the opened clutch as in the system in Drexl and the prior art.

Drexl can limit pressure by using an internal pressure relief device. An internal pressure relief device would be inoperable in the present application because an emergency state comprises information that must be recognized from the behavior detected by external parameters not information from the internal system. Control of the relief valve in Claim 1 has to be initialized outside the pressure circuit and it is necessary that an outside actuator activate the pressure valve. Hence, the recitation in Claim 1 of a relief valve that is operable by a driver via an actuator. This is not taught by Drexl or the prior art in paragraph [0002]. Even if the art was modified to include the pressure relief mechanism as taught by Drexl the essential element of Claim 1 would still be missing, namely, the capability for the driver to operate the pressure relief device with an actuator. In Drexl, there is no way for a driver to actuate or operate the relief valve. To make the pressure relief valve in Drexl controllable by the driver would require a substantial reconstruction and redesign of the device taught by Drexl, as well as change the basic principle under which the Drexl device was designed to operate. Changes that alter the principle of operation of a reference are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d at 810; MPEP 2143.02. Therefore, Claims 1-6 are patentable over Drexl and the prior art described in paragraph [0002] and Applicants request that the rejections of those claims be withdrawn.

The Rejection of Claim 7 under 35 USC § 103 (a)

Claim 7 was rejected under 35 USC §103(a) as unpatentable over admitted prior art described in paragraph [0002] in view of U.S. Patent No. 6,234,290 ("Drexl") as applied to Claims 1-6 above, and in further view of U.S. Patent No. 6,098,772 ("Kimmig"). Applicants respectfully traverse the rejection.

Both Kimmig and the present application were commonly owned by Luk at the time the invention of the present application was made. Under 35 U.S.C. § 103(c), subject matter developed by another person or entity, which qualifies as prior art only under § 102 (e) does not preclude patentability if that subject matter was owned by the same person at the time the invention was made.

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As stated in the Statement of Common Ownership above, Kimmig and the invention of the present application were commonly owned by Luk at the time the invention in Claim 7 of the present application was made. Under § 103(c), Kimmig cannot be cited as disqualifying prior art against Claim 7. Because Kimmig is cited against Claim 7, the current rejection of Claim 7 under § 103 (a) should be withdrawn and that claim passed to allowance. Applicants respectfully request withdrawal of the rejection of Claim 7 and passage to allowance of that claim.

The Rejections of Claims 8-11 and 13 under 35 USC § 103 (a)

Claims 8-11 and 13 were rejected under 35 USC §103(a) as being unpatentable over the admitted prior art described in paragraph [0002] in view of U.S. Patent No. 6,234,290 (“Drex1”) as applied to Claims 1-6 above, and in further view of U.S. Patent No. 3,352,392 (“Black”). Applicants respectfully traverse the rejections.

In accordance with *In re Vaeck*, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicants have shown *supra* that the prior art in paragraph [0002] in view of Drex1 ‘290 does not teach all the limitations of Claim 1. Nor does Drex1 and the prior art in paragraph [0002] suggest all the limitations of Claim 1. Therefore, Claim 1 is patentable over Drex1 ‘290 and the prior art. Claims 8-11 and 13, which depend directly or indirectly from Claim 1, enjoy the same distinction from Drex1 ‘290 and the prior art in paragraph [0002]. Since Black fails to cure the defects of Drex1 and the prior art in paragraph [0002], specifically, the teaching of a pressure relief valve that is operable by a driver via an actuator, Claims 8-11 and 13 are patentable over the prior art in paragraph [0002] in view of Drex1, and in further view of Black. Applicants respectfully request withdrawal of the rejections of Claims 8-11 and 13 and passage to allowance of those claims

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The Rejections of Claims 8, 14 and 16-18 under 35 USC § 103 (a)

Claims 8, 14 and 16-18 were rejected under 35 USC §103(a) as being unpatentable over the admitted prior art described in paragraph [0002] in view of U.S. Patent No. 6,234,290 ("Drexl") as applied to Claims 1-6 above, and in further view of U.S. Patent No. 4,632,234 ("Bardoll"). Applicants respectfully traverse the rejections.

In accordance with *In re Vaeck*, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicants have shown *supra* that the prior art in paragraph [0002] in view of Drexl '290 does not teach all the limitations of Claim 1. Nor does Drexl and the prior art in paragraph [0002] suggest all the limitations of Claim 1. Therefore, Claim 1 is patentable over Drexl '290 and the prior art in paragraph [0002]. Claims 8, 14 and 16-18, which depend directly or indirectly from Claim 1, enjoy the same distinction from Drexl '290 and the prior art in paragraph [0002]. Since Bardoll fails to cure the defects of Drexl and the prior art in paragraph [0002], specifically, the teaching of a pressure relief valve that is operable by a driver via an actuator, Claims 8-11 and 13 are patentable over the prior art in paragraph [0002] in view of Drexl, and in further view of Bardoll. Applicants respectfully request withdrawal of the rejections of Claims 8, 14 and 16-18 and passage to allowance of those claims.

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Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,

A handwritten signature in black ink, appearing to read "C. Richard Lohrman", written in a cursive style.

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